

REMARKS

Applicants note that the present application entered the U.S. national phase prosecution via the PCT. No lack of unity was found during the PCT prosecution. Applicants thus traverse the restriction requirement because it runs contrary to the findings of the PCT Examiner.

Applicants further traverse the restriction requirement because the combination of the Ding patent and the Eder et al. published application (cited in the paragraph spanning pages 2 and 3) of the restriction requirement, is irrelevant to the present claims. Claim 1 is not drawn to a two-part combination of a first *co*-polymer of vinyl acetate, vinyl acetal and vinyl alcohol, and a second *homo*-polymer of poly(vinyl pyrrolidone). (This is the Office's explicit characterization of what this combination of references teaches.) But that is not what is explicitly recited in present Claim 1, which requires a combination of a ternary *co*-polymer and a binary *co*-polymer. Thus, Applicants further traverse the restriction requirement because the Office's citation to the prior art in support of its allegation of lack of a single general inventive concept is without merit.

Applicants further traverse the restriction requirement because it is contrary to 37 CFR §1.475(b). The entire claim set recites a product (the coating and a device bearing the coating), and a process of using the product (applying the coating to a device). Thus, the claim set "will" have unity of invention as per §1.475(b).

Applicants therefore submit that the restriction requirement is improper. Withdrawal of the restriction requirement is respectfully requested.

An election of species requirement is proper only if the restricted species are independent or patentably distinct and there is no serious burden placed on the Office if an election is not required (MPEP §803). The burden is on the Office to provide reasons and/or examples to support any conclusion of patentable distinctness between the restricted species (MPEP §803). Applicants respectfully traverse the election of species requirement on the grounds that the Office has not carried the burden of providing any reason and/or example to support the conclusion that the restricted species are, in fact, distinct.

Also, as noted above, the burden is on the Office to provide sound scientific reasons or examples to support a conclusion of patentable distinctness. In the present instance, the Office states that the species "have mutually exclusive characteristics." The Office, however, fails to identify any of these mutually exclusive characteristics, and fails to identify how these potentially different characteristics render the species patentably distinct from one another. The Office also states that the species "are not obvious variants of each other based on the current record." The Office, however, fails to articulate why this is the case. In short, the Office has simply drawn a conclusion without stating the reasons for how it arrived at that conclusion.

Applicants thus submit that the reasoning offered by the Examiner is insufficient to support a conclusion of patentable distinctness between the restricted species. First, stating that the *co*-polymers of Formula 1 and Formula 2 have "mutually exclusive characteristics" is a tautology - they are *co*-polymers within the same family, but having differing percent compositions. While their chemical properties will be similar, they certainly will not be identical. That statement, however, is nothing more than a restatement of the conclusion of patentable distinctness itself. Simply because the Markush-type groups can be parsed into mutually exclusive species does not mean that the individual species are patentably distinct. In short, it is improper for the Office simply to divide the species into mutually exclusive groups and require an election of species based solely on the mutual exclusivity of the groups articulated by the Office. The MPEP requires a more explicit articulation on the part of the Office in showing patentable distinctness between species in order to sustain an election of species requirement.

With regard to election of species requirements involving Markush-type claims, the Examiner's attention is also directed to MPEP §803.02:

If the members of the Markush groups are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all claims on the merits, even though they are directed to independent and distinct inventions. In such a case the, examiner will not follow the procedure described below and will not require restriction.

In the present case, Applicants respectfully note that the Markush recitations of Claim 1 recite only two members: Formula 1 is a random, ternary *co*-polymer containing a vinyl acetal, vinyl alcohol, and acetate monomers; Formula 2 is a binary *co*-polymer containing vinyl pyrrolidone and vinyl acetate monomers. Two members is an exceedingly small and well-contained group. Yes, there is variety within these two types of *co*-polymers, but at its core, there are only two different ingredients recited in claim 1: a ternary *co*-polymer of specified composition and a binary *co*-polymer of specified composition. Therefore, Applicants respectfully submit that MPEP §803.02, quoted above, controls and the election of species requirement is improper.

Applicants further note that an examination of the entire Markush group can be made without serious burden on the examiner because all of the members are classified within the same class and sub-class designation. Therefore, a search encompassing any of the species falling within the genus necessarily covers the same area as a search for any other species within the genus. Thus, there is no additional search burden on the Office if the election of species is not required because the searches are co-extensive. A search for one member of the Markush group will, by virtue of relatedness of the positively recited *co*-polymers, reveal prior art relevant to the others.

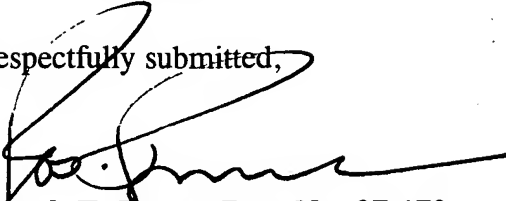
Lastly, Applicants note that with the provisional election of a single species, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claims will be extended (MPEP §803.02).

Accordingly, because the Office has not carried the burden of providing technologically sound reasons or examples for concluding that the restricted species are patentably distinct, the election of species requirement is improper and should be withdrawn.

Applicants submit that the application is now in condition for allowance. Early notification of such action is earnestly solicited.



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